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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,098	11/17/2003	Douglas John Meldrum Allen	62815-A-PCT-US/JPW/GJG/AC	4866

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EXAMINER	
TRUONG, TAMTHOM NGO	
ART UNIT	PAPER NUMBER
1624	

MAIL DATE	DELIVERY MODE
08/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/716,098	ALLEN ET AL.	
	Examiner	Art Unit	
	TAMTHOM N. TRUONG	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13,16-23 and 25-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *13, 16-22, 27 and 28* is/are allowed.

6)☒ Claim(s) *23,25 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5-14-08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

FINAL ACTION

Applicant's amendment of 5-14-08 has been considered. The terminal disclaimer have overcome the previous rejection of Obviousness-type Double Patenting (ODP). However, new claims necessitate the following new ground(s) of rejection.

Claims 1-12, 14, 15 and 24 are cancelled.

Claims 13, 16-23 and 25-28 are pending.

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Scope of Enablement:** Claims 23, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating cancers such as: lung, breast, colorectal, prostate, and ovarian does not reasonably provide enablement for treating other cancers as broadly claimed or non-cancerous hyperproliferative diseases. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The following factors have been considered in the determination of an enabling disclosure:

(1) The breadth of the claims;

(2) The amount of direction or guidance presented;

(3) The state of the prior art;

(4) The relative skill of those in the art;

(5) The predictability or unpredictability of the art;

(6) The quantity of experimentation necessary;

[See ***Ex parte Forman***, 230 USPQ 546 (Bd. Pat. App. & Int., 1986); also ***In re Wands***, 858 F. 2d 731, 8 USPQ 2d 1400 (Fed. Cir. 1988)].

The breadth of the claims: Claim 23 recites a "method of treating a mammal suffering from a hyperproliferative disorder…" The term "hyperproliferative disorder" covers a list of tumors, cancers such as: brain cancer, lung cancer, squamous cell cancer, bladder cancer, gastric cancer, pancreatic cancer, breast cancer, head cancer, neck cancer, renal cancer, kidney cancer, ovarian cancer, prostate cacner, colorectal cancer, oesophageal cancer, gynecological cancer, or thyroid cancer. Thus, the scope of claim 23 and claims dependent thereon is unduly broad.

Claims 25 and 26 depend on claim 23 for the scope of "hyperproliferative disease", and recite other chemotherapeutic agents, and thus, the scope is also unduly broad.

The amount of direction or guidance presented: The claimed compound inhibits epidermal growth factor receptor (EGFR), erbB2, HER3 or HER4. Said receptors are found in cancers such as: breast, ovarian, colorectal, prostate and lung cancer. The specification does not provide data or evidence on reduction of tumor size or cell growth for other cancers that are not related to the cited receptors.

The state of the prior art: The claimed compound is commercially known as Iressa or Gefitinib which, in a preclinical studies, is shown to treat cancers such as: prostate, ovarian, breast, colon, small-cell and non-small-cell lung, and ductal carcinoma. Even for the listed cancers, "only tumors in which inhibition of the receptor results in inhibition of down stream signaling pathways are growth arrested." (see page 861 (right column), **Grünwald V. et. al.**, REVIEW, J. Nat. Can. Inst., Vol. 95, No. 12, 6/18/03). Thus, the state of the art does not correlate the inhibition of EGFR to all types of cancers as encompassed by the term "hyperproliferative disorder". Therefore, the state of the art does not support the scope of the claimed method.

The relative skill of those in the art: There has never been a compound capable of treating cancer generally, let alone treating all kinds of "hyperproliferative disorder". Different types of cancers affect different organs and have different modes of growth and harm to the body as well as different vulnerabilities. Thus, the existence of such a "silver bullet" is contrary to our present understanding in oncology. Therefore, it is beyond the skill of oncologists today to get an agent to be effective against all cancers or all hyperproliferative disorders in general.

The predictability or unpredictability of the art & The quantity of experimentation necessary: The pharmaceutical art has been known for its unpredictability due to various conflicting path ways, or biological factors that are sometimes genetically unique to individuals. In the instant case, the showing of EGFR inhibition alone does not guarantee the compound's effectiveness in treating cancers that are not related to EGFR.

See ***Hoffman v. Klaus*** 9 USPQ 2d 1657, and ***Ex parte Powers*** 220 USPQ 925 regarding type of testing needed to support *in vivo* uses.

Thus, given the unpredictable nature of the art, and the preliminary research in the art, one skilled in the art will have to carry out undue experimentation to practice the method of treatment recited in the above claims. When the best efforts have failed to achieve a goal, it is reasonable for the PTO to require evidence that such a goal has been accomplished, ***In re Ferens***, 163 USPQ 609. The failure of skilled scientists to achieve a goal is substantial evidence that achieving such a goal requires undue experimentation, ***Genetech vs. Novo Nordisk***, 42 USPQ 2nd 1001, 1006.

Allowable Subject Matter

2. Claims 13, 16-22, 27 and 28 are allowed. Said claims are drawn to pharmaceutical compositions with specific dosage limitations of the mesylate salt of the claimed active agent that is not taught or fairly suggested in US'721.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMTHOM N. TRUONG whose telephone number is (571)272-0676. The examiner can normally be reached on M, T and Th (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tamthom N. Truong/

/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624

Tamthom N. Truong
Examiner
Art Unit 1624

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8-15-08